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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,894	07/11/2003	Phillip J. Bouic	58670US004	4040
32692	7590	08/02/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			VO, HAI	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1771	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/617,894

Applicant(s)

BOUIC ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 27-43 and 45-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-26, 44 and 65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1103, 1208, 0317.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 23-26, 44 and 65 in the reply filed on 07/15/2005 is acknowledged. The traversal is on the ground(s) that Group I and II are so interrelated that a search of one group will reveal art to the other. This is not found persuasive because Group I is best classified in 428/156 (unfoamed material) whereas Group II is best classified in 428/304.4 (foamed material). The search of Group I will not reveal art to Group II.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

2. Claims 23-26, and 44 are objected to because of the following informalities:  
  
These claims depend from a nonelected claim 1. Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 23-26, 44 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,797,361. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent since the patent and the application are claiming common subject matter as follows: a foam article having a surface pattern formed by applying pressure to the surface of the article (figures 1 and 2). Therefore, there is no apparent reason why Applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP 804.
5. Claims 23-26, 44 and 65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.10/617,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-48 of copending Application No.10/617,893 fully encompass the presently claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 23, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bambara et al (US 5,350,544). Bambara teaches a rigid, closed cell polyethylene foam article provided with a surface pattern by applying pressure to the surface of the foam article (figure 2, column 4, lines 40-42). Accordingly, Bambara anticipates the claimed subject matter.
8. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/52646. WO'646 teaches a foam strip for masking a gap between a movable panel 11 and another part 12 of the vehicle having a surface pattern formed by applying pressure to the surface of the foam strip (page 4, lines 10-20, figures 1-3). The masking strip is made from an open celled polyester foam having a density from 20 to 30 kg/m<sup>3</sup> (page 4, lines 1-5). Accordingly, WO'646 anticipates the claimed subject matter.
9. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/46056. WO'056 teaches a foam strip for masking a gap

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between two parts of the vehicle having a surface pattern formed by applying pressure to the surface of the foam strip (figures 1A, 1B, page 1, lines 30-33).

The masking strip is made from an open celled polyester foam having a density of 26 kg/m<sup>3</sup> (page 3, lines 15-18). Accordingly, WO'056 anticipates the claimed subject matter.

10. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Francis et al (US 4,996,092). Francis teaches a foam strip for masking a gap between a car door and a car body having a surface pattern formed by applying pressure to the surface of the foam strip (figures 1A and 1B). The masking strip is made from an open celled polyester foam having a density of 26 kg/m<sup>3</sup> (column 4, lines 7-10). Accordingly, Francis anticipates the claimed subject matter.

11. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Bouic (US 6,797,361).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bouc anticipates the claimed subject matter (figures 1-2, column 3, lines 50-55, column 5, lines 50-55).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 795 356.

EP'356 teaches a masking strip for temporarily masking automotive body gaps in paint-spraying operations. The masking strip is made from an open celled polyurethane foam having a density from 20 to 30 kg/m<sup>3</sup> [0002] and [0020]. The masking strip has a plurality of grooves which read on Applicants' surface pattern as shown in figure 1. EP'356 does not specifically disclose how the grooves are formed on the surface of the masking strip. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of masking strip of EP'356 is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The masking strip for temporarily masking automotive body gaps in paint-spraying operations is made from an open celled polyurethane



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foam having a density from 20 to 30 kg/m<sup>3</sup> within the claimed range. The masking strip has a plurality of grooves which read on Applicants' surface pattern. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the masking tape of EP'356. Accordingly, EP'356 anticipates or strongly suggests the claimed subject matter.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

*Hai V*

**HAIVO  
PRIMARY EXAMINER**